REMARKS

This amendment is responsive to the Instant Action mailed December 5, 2005. Claims 17-22, 25, 28 and 29 are under examination all of which stand rejected. In response to the Instant Action, without conceding the merits of the rejections thereof, claims 17 and 19 have been amended, claim 18 has been canceled and claims 49-62 have been withdrawn. No withdrawn claim has been amended and no new claim has been added.

Applicant expressly reserves the right to either file a subsequent application directed to any canceled and/or withdrawn claims or to reintroduce same into the current application in the event that an allowance is not secured by the above-proposed amendments.

Applicant states that neither the amendment of claims 17 and 19 nor the cancellation of claim 18 introduces new matter or requires a change of inventorship pursuant to 37 C.F.R. 1.48(b). Support for the amendment of claim 17 is found throughout the application, particularly at page 16, lines 1-4.

1. Claims 49-62, which were added to the instant application in Applicant's prior submission, have been withdrawn from consideration. Applicant respectfully requests the rejoinder thereof, as well as those claims previously withdrawn, in the event that any one of the pending claims is found to be patentable.

2. Applicant is grateful for the consideration of his arguments in response to the Office Action mailed on May 19, 2004 and for the withdrawal of rejections set forth therein.

3. Claims 17-22, 25, 28 and 29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,889,110 issued in the name of Hutchinson (hereinafter referred to as "the Hutchinson patent") in view of U.S. Patent No. 5,631,020 issued to Okada *et al.* or U.S. Patent No. 4,542,789 issued to Stapp in further view of U.S. Patent No. 5,672,659 issued to Shalaby *et al.*

Without conceding the correctness of the Examiner's argument and in an effort to better distinguish the present invention over the unanticipated 102(e) art, i.e., the Hutchinson patent, Applicant has amended claim 17 to include all of the limitations of original claim 18. Applicant respectfully contends that the Hutchinson patent is directed novel salts composed of a cation derived from a peptide containing at least one basic group and an anion derived from a *carboxy-terminated* polyester, not a generally "charged" polyester as opined by the Examiner. *See* the Hutchinson patent at Abstract, col. 1, lines 8 and 48-49, col. 2, lines 58-5, claim 1 *et al.*, for example. There is no discussion and/or suggestion found in the Hutchinson patent to use a "functionalized biodegradable polyester" particularly one containing a phosphate or sulfate anionic moiety, as recited in claim 1 of the

instant application. In fact, of all of the "suitable" polyesters proposed for use by the Hutchinson patent, *see* the Hutchinson patent col. 3, lines 6-17, none contain either sulfur or phosphorous. With respect to those polyesters functionalized with only a carboxylate moiety, in an effort solely to eliminate any possible confusion with the Hutchinson patent, a *proviso* clause has been appended to claim 17 to eliminate use of a polyester functionalized with only a carboxylate anion at the C-terminal.

None of the other references cited in support of the 103(a) rejection, i.e., U.S. Patent 5,631,020 to Okada cited for the proposition that the sodium oleate is a known surfactant, U.S. Patent No. 4,542,789 to Stapp cited for the proposition that sodium oleate is a known enhancing agent or U.S. Patent No. 5,672,659 cited for the proposition that somatostatin may be formulated as a salt with a charged polyester, expand the primary reference's, i.e., the Hutchinson patent, teachings to include polyesters functionalized with phosphate, sulfate or non-terminal carboxylate anion, and as such, Applicant provides no comment as to relevancy of the teachings of the secondary references with respect to the patentability of the instant invention. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All

words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Since none of the references cited against the patentability of the claimed, novel process teach or suggest the use of the functionalized polyester, claim 17 meets the patentability requirements of 35 U.S.C. §103(a).

With respect to the rejection of claims 20 and 21, it is a basic tenet of patent law that claims dependent upon a nonobvious base claim are also nonobvious. "If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious." *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 17-22, 25, 28 and 29 under 35 U.S.C. §103(a) for being unpatentable over U.S. Patent No. 5,889,110 in view of U.S. Patent No. 5,631,020 or U.S. Patent No. 4,542,789 in further view of U.S. Patent No. 5,672,659.

Request for Rejoinder

Applicant submits that claim 17 is a generic claim and based on the above arguments is in a condition for allowance. Upon the allowance of a generic claim, an Applicant is entitled to consideration of claims to additional species which are written in dependent form as provided for by 37 C.F.R. §1.141. Applicant respectfully

requests that withdrawal of claims 23, 24, 26, 27 and 49-62 be rescinded and that said claims be reconsidered.

CONCLUSION

Reconsideration of the instant Office Action, entry of the requested amendments, rejoinder of the withdrawn claims and allowance of the pending and withdrawn claims are respectfully requested.

Prompt and favorable action is solicited.

Should Examiner Borin deem that any further action by the Applicant would put this application in order for acceptance, he is invited to telephone Applicant's attorney at (508) 478-0144 to facilitate prosecution of this application.

With the exception of the fee for the Petition for a three months extension under 37 C.F.R. §1.136(a), Applicant believes that no fees are due with this response, however, the Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to Deposit Account No. 50-0590.

Respectfully submitted,

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